

Patent
Attorney Docket No.: AUS920010811US1
(IBM-0028)

REMARKS

Applicant thanks the Examiner for conducting a telephone interview regarding the issues in the pending office action. All of the issues discussed during the interview are summarized in the remarks below.

Claims 1-33 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/047,837. Applicant submits a terminal disclaimer, which is attached hereto. Reconsideration and withdrawal of the provisional rejection of claims 1-33 is respectfully requested.

Claims 3-4, 14-17, 20-21 and 29-30 stand objected to for certain informalities. Applicant has amended the claims to correct the informalities. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1-2, 5-15, 18-19, 22-30 and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0111669 of Rossmann, *et al.* Rossmann discloses a system and method of processing a web page. (Rossmann, Abstract). Rossmann discloses the method as including receiving a web page having a number of data elements, classifying the data elements, determining a number of related operations for each of the data elements and outputting the related operations. (Rossmann, Abstract). As Rossmann discloses, the data is extracted from the web page, the user selects one or more related operations, and the extracted data are then output to the one or more related operations, which then processes the extracted data. (Rossmann, ¶ 44). Selecting the related operation causes the extracted data to be sent to the application implementing the related operation. (Rossmann, ¶ 44). For example, using a hotel booking application, the process books a hotel by contacting the hotel booking website, makes reservations, sends confirmations to user, etc. (Rossmann, ¶ 74). It is significant to note that the processor used in the method controls and sends instructions to the remote terminals, as in the case of booking the hotel reservation. Claims 13-17 of Rossmann disclose that the processor is coupled

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to the user terminal, useful for viewing a web page.

Applicant claims saving at least one destination address associated with a remote user device having an electronic telephone directory into a web browser; entering at least one telephone number record into the web browser and automatically sending that record from the web browser to each remote user device at the entered destination addresses. (Claims 1 and 18).

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

In *Jones v. Hardy*, 727 F.2d 1524 (Fed. Cir. 1984), the Federal Circuit stated:

The "difference" may have seemed slight (as has often been the case with some of history's greatest inventions, e.g. the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

Id. at 1528.

In the case *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000), the Court states:

Most, if not all inventions arise from a combination of old elements . . . Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

Id. at 1395

Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented because the cited prior art reference fails to teach or suggest each and every limitation claimed by Applicant. As the Examiner states, the cited prior art reference fails to disclose or teach entering at least one telephone number into a browser and sending the number to at least one destination address that is associated with a remote user device, wherein the destination address is stored in a browser. (Office Action, p. 5). The Examiner states that since it is well known in the art that a person can

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send an email, then one having ordinary skill in the art would know to enter a telephone number into an email editor and send the message. But that is not what Applicant claims.

Applicant claims entering the telephone number record *into the browser* and sending the record from the browser through a network to the destination addresses *entered and saved* in the browser. While an email may be composed, addresses entered into the email and the phone numbers entered into the email message section, as proposed by Examiner, such is simply not claimed by Applicant. To better claim the invention, Applicant has amended claim 18 to include "*automatically sending*" to definitely show the email is not written by a user, addressed by the user and sent by the user as stated by Examiner. Applicant has also added a new claim that includes the limitations of saving the destination address into the web browser.

As the *Kotzab* court stated, most if not all inventions arise from a combination of old elements and there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. Examiner provides no evidence of the motivation as to why one having ordinary skill in the art would combine emailing technology specifically for automatically sending an email containing telephone number records to remote terminals so that these records may be entered into an electronic telephone directory.

Therefore, because the cited prior art references fail to teach or suggest each and every limitation claimed by Applicant, and because there is no motivation for modifying the cited prior art, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1 and 18 as well as all claims depending therefrom.

Claims 3-4, 16-17, 20-21 and 31-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0111669 of Rossmann, *et al.* as applied to claims 1-2, 5-15, 18-19, 22-30 and 33 above and further in view of Official Notice. As provided in the MPEP, "If the applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, an applicant is charged with rebutting the well known statement in the next reply after the office action in which the well known statement was made." (MPEP § 2144.03).

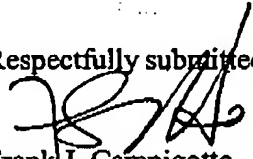
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Regarding claims 3-4 and 20-21, Applicant does not agree that the limitations contained therein are obvious over the well-know art. Applicant traverses the statement that the limitations therein are well-known in the art of the claimed invention.

However, for the reasons provided in the remarks above pertaining to independent claims 1 and 18, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 3-4, 16-17, 20-21 and 31-32, which depend therefrom.

Applicant respectfully asserts that all claims are now in condition for allowance and respectfully requests that a Notice of Allowance be issued. If the Examiner determines that a telephone conference would expedite the examination of this pending patent application, the Examiner is invited to call the undersigned attorney at the Examiner's convenience. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/IBM-0028 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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